



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,275	08/31/2000	Bruce A. Brandt	08049.009	3088

22852 7590 05/09/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &  
DUNNER LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/652,275

Applicant(s)

BRANDT ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) 1-36 and 71-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-70 and 107-140 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of group II in Paper No. 7 is acknowledged.

Claims 1-36 and 71-106 have been removed from consideration by the Examiner.

### ***Information Disclosure Statement***

The 2 Japanese references (JP 4160581 A2 and JP 6154710 A2) and the Dutch patent (NL 850115015) have been considered only insofar as their English abstract allows. The Examiner has no way of ascertaining the nature of the disclosure of these documents.

### ***Specification***

The disclosure is objected to because the Summary of the Invention section does not include a description of the claimed subject matter. Further, it does not suggest a utility for any elements of the elected claims.

The Summary of the Invention should adequately describe the identification code reader unless applicant feels that the code reader is well known in the art, the identification code itself in the case that applicant feels that the identification code is a key aspect of the novelty of the invention, and above all the Summary of Invention should describe the sorter application software and assert a utility for it which

Art Unit: 3653

distinguishes it over known software which is used to communicate between mail sorters and their associated computer control systems, databases, etc.

Of course, this should be included only insofar as it has already been described in the detailed description.

Appropriate correction is required.

***Note from Examiner***

In the absence of a descriptive Summary of the Invention, and a background summary which does not describe the most closely related prior art in any detail, the Examiner cannot establish what the Applicant feels is the actual improvement over the art being set forth in this application. Is it the "common sorter" software, the Identification code, or the use of a server to communicate with the mail processing device?

Thus, insofar as the elements of the independent claims exist in the art, they have been duly rejected below. As so many references anticipate the broad independent claims, no allowability or suggestions thereof are here proposed. Further, the Examiner cannot assert that the search performed was complete. In fact, the search might have been completely irrelevant to the applicant's intended invention. However, such things are hard to determined when multiple references are retrieved which anticipate the claims and the Summary of Invention is so short and directed to a non-claimed (non-elected) invention.

Art Unit: 3653

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 37-70 and 107-140 are rejected under 35 U.S.C. 102(b) as being anticipated by WO98/17405.

The Examiner is using US 6,292,709 B1 as an English translation of that document, it being believed that all of the elements used for rejection here are present in the PCT application published 4/30/1998.

See figure 13 and column 10. The reference teaches a mail processing device, an identification code reader connected to the mail processing device, and sorter application software for communicating between the mail processing device and an identification code server.

The identification code server is explicitly labeled "ID Tag server". The bar code reader (422) is the identification code reader. The sorter application software is naturally inherent in the control (421), and the ID-Tag server and sorter themselves, as a server cannot communicate with a mail sorter without some form of pertinent software, said software being considered sorting application software, because it deals with (transfers) bar code information being sent to the server, and decisions being sent to the sorter, all of which deal with sorting information.

The Examiner considers the sorters of the reference to be Mail Processing Bar Code Sorters (as they process mail and use bar code), Delivery Bar Code Sorters (as they assemble mail for delivery and use bar code), Carrier Sequence Bar Code Sorter

Art Unit: 3653

(as they eventually deliver sorted mail to a carrier and use bar code), and Output Subsystem/Bar Code Sorters (as they are output sorters which are in themselves a subsystem and use bar code). The Examiner considers the code reader a RBCS ID Tag reader because the reader reads an ID Tag in a bar code system which is remote of the server. The code reader is a Universal ID Tag reader because the ID Tag is also used by the network and other sorters.

As the system of Figure 13 is to be used in communication with identical systems along the network connection shown, the code server is a primary ICS server and the second, third, etc. servers in communication therewith are secondary ICS servers. (Applicant is reminded that, unless it is wished that this application serve as lexicography code in itself, the capitalization of terms and acronyms are interpreted as broadly as possible. In any instance, the Examiner believes this reference matches up well with the devices and systems discussed in the specification.

WO98/17405, via US 6,292,709, teaches the method of reading an ID code from a mailpiece using an ID code reader, transmitting the identification code to an identification code server, via "sorter application" software, and processing mailpiece information between the sorter and the ID code server, via "sorter application" software.

The reference inherently teaches the code and computer readable medium described in relation to the system. Although it is never described verbatim in the reference, it is just as inherent in the system of the reference as it is inherent and not taught verbatim by the instant application.

Art Unit: 3653

Claims 37-70 and 107-140 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,249,687.

The Examiner interprets CPU 23' as a server, insofar as it serves as the central processor and controller for at least three workstations, a communion network adaptor, a bar code reader, a shared printer, and offers communication capability with a sorter and the network itself, along the bus. Again, the "sorting application" software is inherent, in that it is impossible for the sorting machine hardware to connect to the bus without code translation or emulation of some sort.

Bar code reader is explicitly shown. The identification code of the mailpiece is described in column 5, lines 8-10. The bus and other data communication elements are described in column 6, lines 22-40.

The system of the reference creates a serial number for each mailpiece, associates it with an electronic file, and offers complete shared access along a bus, which connects to a network along 29.

A description of the general nature of this type of sorting device/method is given in column 1. Again, it is difficult for the Examiner to infer what the advantages of the claimed invention of the instant application are over this description.

Again, the computer readable medium and code of claims 69 and 139 are inherent in the fact that the reference has the components of claim 1 and performs the method of claim 47. The system of the reference would not function without such a code.

Explicitly taught are the reading of an ID code from the mailpiece, transmitting the ID code to an ID code server (controlling/serving PCU) via software, and processing mailpiece information (the electronic file and/or sorting instructions) between the sorter and the server, via the software.

The Examiner considers the sorters of the reference to be Mail Processing Bar Code Sorters (as they process mail and use bar code), Delivery Bar Code Sorters (as they assemble mail for delivery and use bar code), Carrier Sequence Bar Code Sorter (as they eventually deliver sorted mail to a carrier and use bar code), and Output Subsystem/Bar Code Sorters (as they are output sorters which are in themselves a subsystem and use bar code). The Examiner considers the code reader a RBCS ID Tag reader because the reader reads an ID Tag in a bar code system which is remote of the server. The code reader is a Universal ID Tag reader because the ID Tag is also used by the network and other sorters.

As the system of Figure 1 is to be used in communication with identical systems along the network connection shown, the code server is a primary ICS server and the second, third, etc. servers in communication therewith are secondary ICS servers.

Claims 37-70 and 107-140 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,667,078.

As this reference is similar to US 5,249,687, the rejection is identical. The reference numbers correspond exactly. Figure 2 gives the most detailed portrayal of the elements of the independent claims of the instant application.



Claims 37-70 and 107-140 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,518,122.

The non-real-time CPU (275) of this reference is interpreted as the server. It communicates and controls the timing of real-time CPU, serving as the highest layer of a multi-tiered system including state supervisor, encoder supervisor, inserter supervisor, etc.

The system is modular, intended to be used with other similar systems, and providing communication links therebetween. Barcode reader (220) sends barcode information to the real-time CPU, at which time an electronic file is accessed via several alternate means. All communications are performed along a bus, and are controlled directly via a real-time CPU but run via the non-real time PC, as concerns the timing of information exchange, user prompts, etc. Sorting is performed Although the barcode reader is not directly related to an "Identification code" as defined by applicant, the reader, mail processing device, and sorter application software exist as claimed in the independent claims of the instant application.

The code itself, its contents, its use, etc, has not been claimed in the claims of the instant application. Therefore, as the reference uses a code to identify and sort documents, it still anticipates the claims through comprising all the elements of the apparatus claims and teaching the method claims.

The Examiner considers the sorters of the reference to be Mail Processing Bar Code Sorters (as they process mail and use bar code), Delivery Bar Code Sorters (as

Art Unit: 3653

they assemble mail for delivery and use bar code), Carrier Sequence Bar Code Sorter (as they eventually deliver sorted mail to a carrier and use bar code), and Output Subsystem/Bar Code Sorters (as they are output sorters which are in themselves a subsystem and use bar code). The Examiner considers the code reader a RBCS ID Tag reader because the reader reads an ID Tag in a bar code system which is remote of the server. The code reader is a Universal ID Tag reader because the ID Tag is also used by the network and other sorters.

The Examiner notes, for the record, his interpretation of the term "server".

A "server" is defined by Webster (10<sup>th</sup> Edition) as being "a computer in a network that is used to provide services (as access to files or shared peripherals or the routing of electronic mail) to other computers in the network.

Thus, the presence of a bus in each reference, with at least a plurality of components, each comprising a processor itself, controlled by a master PC, evidences of a server, even though the word "server" is not used.

Further, it is clear from the above definition and from the Examiner's own use of email that an Email server in an agency, company, or firm, also anticipates the independent claims of the instant application. As email is sorted on each user's PC and each email is associated with an identifier on the network and in the server.

### ***Conclusion***

Art Unit: 3653

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. \*\*\*

Other references which anticipate the claims are to be found in the cited art, as well as in the IDS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dk  
May 6, 2002

Application/Control Number: 09/652,275  
Art Unit: 3653

Page 11



DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600